

PATENT COOPERATION TREATY

PCT

NOTIFICATION OF ELECTION

(PCT Rule 61.2)

From the INTERNATIONAL BUREAU

To:

Assistant Commissioner for Patents
United States Patent and Trademark
Office
Box PCT
Washington, D.C.20231
ETATS-UNIS D'AMERIQUE

in its capacity as elected Office

Date of mailing (day/month/year) 07 June 2000 (07.06.00)	
International application No. PCT/EP99/07980	Applicant's or agent's file reference NV/P-21868/A
International filing date (day/month/year) 21 October 1999 (21.10.99)	Priority date (day/month/year) 02 November 1998 (02.11.98)
Applicant HÜGLIN, Dietmar et al	

1. The designated Office is hereby notified of its election made:

☒ in the demand filed with the International Preliminary Examining Authority on:
08 May 2000 (08.05.00)

☐ in a notice effecting later election filed with the International Bureau on:

2. The election ☒ was
☐ was not

made before the expiration of 19 months from the priority date or, where Rule 32 applies, within the time limit under Rule 32.2(b).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer Olivia RANAIVOJAONA
Facsimile No.: (41-22) 740.14.35	Telephone No.: (41-22) 338.83.38

ENT COOPERATION TRE

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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)



Applicant's or agent's file reference HP/2-21868/A	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP99/07980	International filing date (day/month/year) 21/10/1999	Priority date (day/month/year) 02/11/1998
International Patent Classification (IPC) or national classification and IPC A61K7/00		
Applicant CIBA SPECIALTY CHEMICALS HOLDING INC..et al.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.


2. This REPORT consists of a total of 8 sheets, including this cover sheet.

- ☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☒ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☒ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☒ Certain defects in the international application
- VIII ☒ Certain observations on the international application

Date of submission of the demand 08/05/2000	Date of completion of this report 19.10.2000
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel: +49 89 2399 - 0 Tx: 523656-epmu-d Fax: +49 89 2399 - 4465	Authorized officer Ortega Plaza, M.D. Telephone No. +49 89 2399 8284



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/EP99/07980

I. Basis of the report

1. This report has been drawn on the basis of (*substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.*):

Description, pages:

1-39 as originally filed

Claims, No.:

1-15 as originally filed

2. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

4. Additional observations, if necessary:

III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application.
- ☒ claims Nos. 2, 3, 4,5-13.

because:

- ☐ the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (*specify*):

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/EP99/07980

- ☒ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 2, 3, 4, 5-13 are so unclear that no meaningful opinion could be formed (*specify*):

see separate sheet

- ☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
- ☐ no international search report has been established for the said claims Nos. .

IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees the applicant has:

- ☐ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☐ neither restricted nor paid additional fees.

2. ☒ This Authority found that the requirement of unity of invention is not complied and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- ☐ complied with.
- ☒ not complied with for the following reasons:

see separate sheet

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☒ all parts.
- ☐ the parts relating to claims Nos. .

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/EP99/07980

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims
	No:	Claims 1, 14, 15
Inventive step (IS)	Yes:	Claims
	No:	Claims 1, 14, 15
Industrial applicability (IA)	Yes:	Claims 1, 14, 15
	No:	Claims

2. Citations and explanations

see separate sheet

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

Re Item III

Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. Claim 5 relates to the **use** of the light stabilizer according to claim 1 **in** body-care products for the skin and its adnexa. Having regard for the fact that body-care products comprising the light stabilizers according to claim 1 are known as components of body-care compositions, claim 5 does not define in a clear manner the contribution made to the art by the present invention. Use claims should clearly define the new and inventive technical effect linked to the invention.

An analogous objection applies to claim 12 which relates to the **use** of the light stabilizer according to claim 1 **in** household cleaning and treating agents.

The above analysis applies mutatis mutandis to claims 6 to 11 as dependent on claim 5 and to claim 13 as dependent on claim 12.

2. Claim 4 lacks clarity, since although it has been worded as dependent claim of claim 1 it is not encompassed by claim 1 (cf. definitions of L_1).
3. Dependent claims 2 and 3 also lack clarity, since the substituent R_2 which is fixed at position ortho to the hydroxy group in the compounds of formula (1) in claim 1 appears free to be linked in any of the other meta and para positions.

Re Item IV

Lack of unity of invention

In view of the fact that Benzotriazole and Triazine derivatives are known as light stabilizers and as UV filters the present application relates to a multitude of inventions which are not linked by a single inventive concept. The reasons lie in the fact that there are separate closest prior art documents and separate technical problems to be solve which relate to a selection of derivatives for their use as enhanced stabilizers of compositions suitable for several uses.

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/EP99/07980

Re Item V

Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. The following documents have been considered for the establishment of the present preliminary report:

D1 = FR-A-2194442

D2 = GB-A-2286774

D3 = US-A-3983132

D4 = US-A-5760111

D5 = US-A-5688995

D6 = WO-A-9628431

D7 = US-A-5142059

2. Claims 14 and 15 lack novelty in the light of the cited prior art, since a known product does not become novel in view of an effect of one of its components. Compositions and products suitable for body-care and/or household cleaning comprising the light stabilizers as defined in claim 1 are known (cf. D1, D2, D3, D4, D5, D6).

D1 discloses benzotriazol derivatives as those of formula (1) according to claim 1 and its use as solar filters.

D2 discloses triazine derivatives as those of formula (2) as UV absorbers components in sunscreen compositions.

The use "for protecting body-care and household products from photolytic degradation" can be considered to be novel vis-à-vis the contents of D1, D2 in view of the fact that the mentioned prior art discloses the compounds as solar filters, i.e. as UV filters, more specifically UV-filters for the skin.

D3 discloses i.a. the use of 2-(5'-dodecyl-2'-hydroxyphenyl)benzotriazole as light stabilizer for liquid compositions (see compound of formula (1) of present claim 1, wherein m is 1 and R₂ is H). Its use as stabilizers for cosmetic compositions is

explicitly mentioned in column 2 of D3. Hence, D3 destroys the novelty of the subject-matter of claim 1.

D4 anticipates the subject-matter of claim 1, since it discloses triazine derivatives as those of formula (2) and their use as light stabilizers, i.a. for cosmetic compositions (cf. column 17). D4 also discloses mixtures of triazines and benzotriazoles as UV absorbers and compositions containing them.

D5 anticipates the subject-matter of claim 1, since it discloses triazine derivatives as those of formula (2) according to present claim 1 and their use as UV absorbers and light stabilizers i.a. in cosmetics.

D6 discloses triazine derivatives as light stabilizers and UV absorbers in and for compositions of different types. Accordingly its contents are contrary to the novelty of the presently claimed subject-matter.

D7 discloses benzotriazole derivatives as those of formula (1) of present claim 1 as UV absorbers and light stabilizers for wool and polyamide fibers.

The presently claimed use (claim 1) is implicit to the use as light stabilizers, a different wording does not bring novelty over known uses.

3. The solution to the problem of providing light stabilizers for body care products and households products by using the known UV absorbers and light stabilizers is evident from the cited prior art.

Re Item VII

Certain defects in the international application

A reference to D1-D7 is lacking in the description.

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/EP99/07980

R It m VIII

Certain observations on the international application

1. Claim 1 contains some errors: R_8 should read R_3 most probably and no subindex "p" which has been defined as 1 to 3 can be found in the formulae.
2. The fact that the compounds are in fact used "as light stabilizers" is lacking in claim 1. This is an essential feature of the invention (Article 6).

PATENT COOPERATION TREATY

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INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference NV/P-21868/A	FOR FURTHER ACTION see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.	
International application No. PCT/EP 99/ 07980	International filing date (day/month/year) 21/10/1999	(Earliest) Priority Date (day/month/year) 02/11/1998
Applicant CIBA SPECIALTY CHEMICALS HOLDING INC..et al.		

This International Search Report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This International Search Report consists of a total of 3 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

b. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international search was carried out on the basis of the sequence listing :

☐ contained in the international application in written form.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority in written form.

☐ furnished subsequently to this Authority in computer readable form.

☐ the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

☐ the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished

2. ☐ **Certain claims were found unsearchable** (See Box I).

3. ☐ **Unity of invention is lacking** (see Box II).

4. With regard to the **title**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the **drawings** to be published with the abstract is Figure No.

☐ as suggested by the applicant.

☐ because the applicant failed to suggest a figure.

☐ because this figure better characterizes the invention.

☐ None of the figures.

PATENT COOPERATION TREATY

WO 00/25730
PCT/EP99/07980

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From the INTERNATIONAL BUREAU

PCT

NOTICE INFORMING THE APPLICANT OF THE COMMUNICATION OF THE INTERNATIONAL APPLICATION TO THE DESIGNATED OFFICES

(PCT Rule 47.1(c), first sentence)

To:	
CIBA SPECIALTY CHEMICALS HOLDING INC.	
Patentabteilung	Ressort P/TM/SL LE 5
Klybeckstrasse 141	
CH-4057 Basel	9. Mai 2000
SUISSE	
PATA	PATH
SES	HPF
28	

Date of mailing (day/month/year) 11 May 2000 (11.05.00)		Applicant's or agent's file reference PCT/EP99/07980		IMPORTANT NOTICE	
International application No. PCT/EP99/07980	International filing date (day/month/year) 21 October 1999 (21.10.99)	Priority date (day/month/year) 02 November 1998 (02.11.98)	Applicant CIBA SPECIALTY CHEMICALS HOLDING INC. et al		

1. Notice is hereby given that the International Bureau has communicated, as provided in Article 20, the international application to the following designated Offices on the date indicated above as the date of mailing of this Notice:
AU,CN,JP,KP,KR,MA,US

In accordance with Rule 47.1(c), third sentence, those Offices will accept the present Notice as conclusive evidence that the communication of the international application has duly taken place on the date of mailing indicated above and no copy of the international application is required to be furnished by the applicant to the designated Office(s).

2. The following designated Offices have waived the requirement for such a communication at this time:
AE,AL,AM,AP,AT,AZ,BA,BB,BG,BR,BY,CA,CH,CR,CU,CZ,DE,DK,DM,EA,EE,EP,ES,FI,GB,GD,GE, GH,GM,HR,HU,ID,IL,IN,IS,KE,KG,KZ,LC,LK,LR,LS,LT,LU,LV,MD,MG,MK,MN,MW,MX,NO,NZ,OA, PL,PT,RO,RU,SD,SE,SG,SI,SK,SL,TJ,TM,TR,TT,TZ,UA,UG,UZ,VN,YU,ZA,ZW
The communication will be made to those Offices only upon their request. Furthermore, those Offices do not require the applicant to furnish a copy of the international application (Rule 49.1(a-bis)).
3. Enclosed with this Notice is a copy of the international application as published by the International Bureau on 11 May 2000 (11.05.00) under No. WO 00/25730

REMINDER REGARDING CHAPTER II (Article 31(2)(a) and Rule 54.2)

If the applicant wishes to postpone entry into the national phase until 30 months (or later in some Offices) from the priority date, a demand for international preliminary examination must be filed with the competent International Preliminary Examining Authority before the expiration of 19 months from the priority date.

It is the applicant's sole responsibility to monitor the 19-month time limit.

Note that only an applicant who is a national or resident of a PCT Contracting State which is bound by Chapter II has the right to file a demand for international preliminary examination.

REMINDER REGARDING ENTRY INTO THE NATIONAL PHASE (Article 22 or 39(1))

If the applicant wishes to proceed with the international application in the national phase, he must, within 20 months or 30 months, or later in some Offices, perform the acts referred to therein before each designated or elected Office.

For further important information on the time limits and acts to be performed for entering the national phase, see the Annex to Form PCT/IB/301 (Notification of Receipt of Record Copy) and Volume II of the PCT Applicant's Guide.

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer J. Zahra
Facsimile No. (41-22) 740.14.35	Telephone No. (41-22) 338.83.38

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference NV/P-21868/A	<div style="display: flex; justify-content: space-between;"> <div style="text-align: center;"> FOR FURTHER ACTION </div> <div style="font-size: small;"> see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below. </div> </div>	
International application No. PCT/EP 99/ 07980	International filing date (day/month/year) <div style="text-align: center;">21/10/1999</div>	(Earliest) Priority Date (day/month/year) <div style="text-align: center;">02/11/1998</div>
Applicant CIBA SPECIALTY CHEMICALS HOLDING INC..et al.		

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☐ contained in the international application in written form.

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☐ furnished subsequently to this Authority in written form.

☐ furnished subsequently to this Authority in computer readable form.

☐ the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

☐ the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished

2. ☐ Certain claims were found unsearchable (See Box I).

3. ☐ Unity of invention is lacking (see Box II).

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☐ the text has been established by this Authority to read as follows:

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6. The figure of the drawings to be published with the abstract is Figure No.

☐ as suggested by the applicant.

☐ because the applicant failed to suggest a figure.

☐ because this figure better characterizes the invention.

☐ None of the figures.

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PCT 99/07980

IPC 7 A61K7/00 C11D1/00

IPC 7 A61K C11D C07D C08K

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

Stienon, P

INTERNATIONAL SEARCH REPORT

International Application No

PC 99/07980

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 5 688 995 A (LUTHER HELMUT ET AL) 18 November 1997 (1997-11-18) claims 1-8	1,3,5-7, 9,10, 12-15
X	WO 96 28431 A (CIBA GEIGY AG ;FLETCHER IAN JOHN (CH); KASCHIG JUERGEN (DE); METZG) 19 September 1996 (1996-09-19) page 40, paragraph 3 -page 42, paragraph 2 example 28 claims 1-24	1,5-7, 10,12-15
X	US 5 142 059 A (BURDESKA KURT ET AL) 25 August 1992 (1992-08-25) abstract claims 1-5	1,12,13, 15

INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PC 99/07980

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
FR 2194442	A	01-03-1974	HU 164662 B CH 583560 A DE 2338833 A NL 7310246 A	28-03-1974 14-01-1977 14-02-1974 04-02-1974
GB 2286774	A	30-08-1995	AT 188374 T AU 700081 B AU 1665395 A BR 9506935 A DE 69514330 D WO 9522959 A EP 0746305 A JP 9509421 T US 5869030 A ZA 9501459 A	15-01-2000 17-12-1998 11-09-1995 09-09-1997 10-02-2000 31-08-1995 11-12-1996 22-09-1997 09-02-1999 23-08-1995
US 3983132	A	28-09-1976	CA 1077046 A CH 602676 A DE 2536779 A FR 2282462 A GB 1481775 A IT 1041807 B JP 1293977 C JP 51049719 A JP 60014062 B US 4096242 A US 4129521 A US RE29596 E	06-05-1980 31-07-1978 11-03-1976 19-03-1976 03-08-1977 10-01-1980 16-12-1985 30-04-1976 11-04-1985 20-06-1978 12-12-1978 28-03-1978
US 5760111	A	02-06-1998	AU 681196 B AU 7896794 A BR 9404689 A CA 2136272 A CZ 9402864 A EP 0654469 A HU 68707 A JP 7233154 A PL 305938 A SK 140294 A US 5591850 A ZA 9409247 A	21-08-1997 01-06-1995 18-07-1995 24-05-1995 14-06-1995 24-05-1995 28-07-1995 05-09-1995 29-05-1995 07-06-1995 07-01-1997 23-05-1995
US 5688995	A	18-11-1997	AU 712153 B AU 5235796 A BR 9602339 A EP 0743309 A JP 8337574 A NZ 286600 A	28-10-1999 28-11-1996 01-09-1998 20-11-1996 24-12-1996 28-07-1998
WO 9628431	A	19-09-1996	AU 700194 B AU 4945596 A BR 9607477 A CA 2211749 A EP 0815089 A JP 11503112 T NO 974224 A	24-12-1998 02-10-1996 23-12-1997 19-09-1996 07-01-1998 23-03-1999 06-11-1997
US 5142059	A	25-08-1992	AU 634578 B	25-02-1993

INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PC 99/07980

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
US 5142059 A		AU 6235690 A	14-03-1991
		EP 0418198 A	20-03-1991
		JP 3118373 A	20-05-1991
		ZA 9007173 A	29-05-1991

FOR THE PURPOSES OF INFORMATION ONLY

Codes used to identify States party to the PCT on the front pages of pamphlets publishing international applications under the PCT.

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CG	Congo	KE	Kenya	NO	Norway	YU	Yugoslavia
CH	Switzerland	KG	Kyrgyzstan	NZ	New Zealand	ZW	Zimbabwe
CI	Côte d'Ivoire	KP	Democratic People's Republic of Korea	PL	Poland		
CM	Cameroon	KR	Republic of Korea	PT	Portugal		
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CZ	Czech Republic	LI	Liechtenstein	SD	Sudan		
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DK	Denmark	LR	Liberia	SG	Singapore		
EE	Estonia						